

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 105

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

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PAT & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JOHANNES G. BEDNORZ and CARL A. MUELLER

Appeal No. 2001-0809  
Application No. 08/303,561

REMAND

Before GARRIS, WALTZ, and MOORE, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is hereby remanded to the jurisdiction of the Examining Corps in order for the examiner to attend to certain matters discussed below<sup>1</sup>.

<sup>1</sup> As a matter of clarification, we point out that the oral hearing scheduled for February 18, 2003 has been vacated by Craig R. Feinberg, Program and Resource Administrator for the Board of Patent Appeals and Interferences, on February 13, 2003 via a

(continued...)

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On or about December 24, 1998, a Notice of Appeal was filed in this application. Subsequent to the Notice of Appeal filing, numerous communications were filed by the appellants. These communications include an Appeal Brief filed on or about July 1, 1999, a Substitute Appeal Brief filed on or about January 18, 2000 (in response to the examiner's Notice of Defective Brief), a Reply (to the Examiner's Answer) filed on or about July 19, 2000, a Supplemental Reply (to the Examiner's Answer) filed on or about August 7, 2000, a Substitute Supplemental Reply (to the Examiner's Answer) filed on or about August 28, 2000, a Second Supplemental Reply (to the Examiner's Answer) filed on or about October 10, 2000, a Third Supplemental Reply (to the Examiner's Answer) filed on or about February 5, 2002 and a Fourth Supplemental Reply (to the Examiner's Answer) filed on or about February 14, 2003. Many of these communications include "attachments" which comprise exhibits submitted by the appellants (i.e., evidentiary submissions) in support of their argued positions advanced in the previously mentioned "Briefs" and "Replies."

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<sup>1</sup>(...continued)  
telephone communication to Daniel P. Morris, attorney for the appellants.

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In accordance with current Office policy and procedure, the examiner has entered, considered and responded to the appellants' Substitute Brief and has entered and considered (though not responded to) the appellants' various "Reply" Briefs. However, the record before us lacks clarity with respect to the status of the many attachments including exhibits which were filed with the appellants' Substitute and Reply Briefs. In particular, it is unclear whether or not these attachments including exhibits have been entered into the official file record for this application.

There are many reasons for this lack of clarity, a number of which stand out as most significant. Specifically, the appellants have submitted a voluminous number of communications including attachments such as exhibits subsequent to the final Office action and subsequent to the Notice of Appeal. Some of these submissions have been entered, some have not, and some have not been explicitly commented upon by the examiner as to whether they are entered or not entered. The lack of clarity occasioned by these circumstances is compounded by the fact that the appellants in their Substitute and Reply Briefs rely upon exhibits as support for their argued positions without delineating, and without regard to, whether these exhibits have been entered by the examiner. Indeed, the appellants have

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expressly relied upon exhibits which the examiner has officially refused to enter and consider (e.g., see pages 105-113 of the Substitute Brief in comparison with the penultimate paragraph on page 21 of the Answer as well as the paragraph bridging pages 4 and 5 of the appellants' Reply (to the Examiner's Answer) filed on or about July 19, 2000)<sup>2</sup>.

It is necessary to rectify this lack of clarity problem in order to enable the Board to perform its appellate review function. Toward this end, we remand the subject application to the jurisdiction of the Examining Corps so that the examiner can take whatever actions may be necessary and appropriate to achieve the following objectives.

The file record must be clarified as to the entry versus non-entry status of each attachment including exhibit which was associated with and/or was referenced in the appellants' Substitute and Reply Briefs. With respect to any such attachment including exhibit which has not already been entered, the examiner and the appellants are reminded of the requirement in 37 CFR § 1.195 that "[a]ffidavits, declarations, or exhibits

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<sup>2</sup>We view with disfavor the appellants' reliance upon exhibits which they know the examiner has officially refused to enter and consider. It is particularly disfavorable that the appellants have relied on these exhibits without disclosing their non-entered status to the Board.

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submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented." See also the Manual of Patent Examining Procedure (MPEP) § 1207, § 1208.03, § 1211.01 and § 1211.02 (8<sup>th</sup> ed., Aug. 2001). Pursuant to this requirement, any newly submitted attachments including exhibits associated with the appellants' Substitute and Reply Briefs should not be admitted into the file record of this application in the absence of "a showing of good and sufficient reasons why they were not earlier presented." If the examiner determines that any such attachment including exhibit should be admitted (i.e., entered) into the application file record, then the examiner must set forth in the record a clear statement as to whether the entered attachment/exhibit overcomes any of his rejections and, if not, why not. For the purpose of accomplishing this last mentioned explanation (and for the purpose of responding to any corresponding argument made by the appellants), the examiner is hereby authorized to issue any supplemental Examiner's Answer(s) in response to any currently pending or subsequently filed briefs by the appellants. See MPEP § 1211.

In addition to and consonant with the foregoing, the file record for this appeal must be clarified in relation to the

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status of evidence including affidavits, declarations and exhibits upon which the appellants rely in support of their arguments. As previously indicated, the appellants' now-pending Substitute and Reply Briefs refer to and rely upon evidence (e.g., attachments in the form of exhibits) without delineating, and without deference to, whether or not this evidence has been entered by the examiner. It would be antithetical to effective and just appellate review if the members of this Board panel were to be influenced by evidence which we mistakenly thought had been entered and considered by the examiner. Thus, the Substitute and Reply Briefs filed by the appellants heretofore must be regarded as defective because the evidentiary submissions referred to and relied upon in these briefs are not limited to only evidence which has been entered and considered by the examiner.

In order to achieve the above discussed objectives of this remand, we hereby cede to the examiner our authority under 37 CFR § 1.196(d) for the purpose of formally notifying the appellants that their now-pending Substitute and Reply Briefs are defective for the reasons previously mentioned and requiring the appellants to timely file a substitute brief which overcomes the defect (i.e., by referring and relying only upon evidence such as exhibits which have been entered and considered by the examiner).

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In this regard, the appellants also should be required to annotate their references to evidence in the substitute brief with an identification of the specific portion of the file record which reflects that the examiner has entered and considered the evidence in question. If such annotation is not possible because the examiner has not yet considered whether to enter or not enter the evidence, this fact should be expressly stated in the substitute brief. In this way, the appellants will assist the examiner in achieving the aforementioned objective of identifying and resolving the entry versus non-entry status of each evidentiary submission relied upon by the appellants in connection with this appeal.

In summary, the examiner should respond to this remand by notifying the appellants that their currently pending Substitute and Reply Briefs are defective and by requiring the appellants to timely file a substitute brief which corrects the defect (as discussed more fully above). Additionally, the examiner should respond to any such substitute brief by mailing a supplemental Examiner's Answer (if appropriate) and by clearly identifying the entry versus non-entry status of any evidence which is referred to in the substitute brief if necessary such as evidence which is not already of record (as more fully discussed above).

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At this point, we now turn our attention to the "REQUEST FOR REMAND" made by the appellants in their Reply (to the Examiner's Answer) filed on or about July 19, 2000. More particularly, the appellants have made three separate requests for remand of the subject application for three separate reasons. In our discussion below, we will individually consider these requests and set forth our response to them.

On pages 1-4 of the July 19, 2000 Reply, the appellants argue that the examiner has introduced a new ground of rejection under the first paragraph of 35 U.S.C. § 112 and request that their application be remanded to the examiner for consideration of data in response to this new ground of rejection. From our perspective, the appellants have erroneously concluded that the examiner has introduced a new ground of rejection in his answer. The section 112, first paragraph, rejection in the answer, like the corresponding rejection in the final Office action, is based on the examiner's position that the scope of enablement provided by the appellants' disclosure is more narrow than the scope of protection sought in the rejected claims. We recognize that the examiner in his answer reconsidered and then dropped his section 112, first paragraph, rejection with respect to certain, relatively narrow claims. However, this fact does not somehow



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transform the examiner's continued rejection of the other claims into a new ground of rejection. In any event, any allegation that an Examiner's Answer contains an impermissible new ground of rejection must be raised by petition under 37 CFR § 1.181(a) rather than by way of appeal to the Board. In these respects, see MPEP § 1208.01 and § 1201 as well as MPEP Chapter 1000 generally.

In light of the foregoing, the appellants' request that we remand their application to the examiner for consideration of data in response to a new ground of rejection is hereby denied.

On pages 4-5 of their July 19, 2000 Reply, the appellants request that their application be remanded for entry and consideration of certain submissions which the appellants filed subsequent to the final Office action and which the examiner refused to enter and consider. Here, as in their previously discussed request, the appellants have incorrectly assumed that the Board is the appropriate forum by which to seek redress of their alleged grievance. It is not. Instead, the propriety of an examiner's refusal to enter a submission filed subsequent to the final Office action is by way of petition not appeal. Again, see MPEP § 1201 and compare § 1002.02(c).

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Under these circumstances, we also deny the appellants' request that their application be remanded "for these after final submissions to be entered and considered" (July 19, 2000 Reply, page 5).

Finally, the appellants request that their application be remanded because the examiner who prepared the final Office action was replaced with a "new" examiner who prepared the Examiner's Answer for this appeal. In this regard, it is the appellants' belief that "further progress in either resolving all the issues remaining in this appeal or substantially simplifying the issues in this appeal can be made by remanding this application to the new examiner" (July 19, 2000 Reply, page 6). This request also is denied. The appellants' belief, even if well founded, is simply not relevant to any established basis for the remand of an application by the Board. See MPEP § 1211, § 1211.01, § 1211.02 and § 1211.03. In any event, we are aware of no authority and the appellants point to none which empowers the Board to require that an examiner reopen prosecution or take some other such action based on the mere possibility that the issues in an appeal could be resolved or simplified.

In conclusion, we have denied each of the appellants' requests that their application be remanded for the particular

reasons identified in the July 19, 2000 Reply. Nevertheless, we hereby remand this application to the examiner for the reasons discussed previously in this opinion.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Bradley R. Garriss )  
Administrative Patent Judge )  
Thomas A. Waltz )  
Thomas A. Waltz )  
Administrative Patent Judge )  
James T. Moore )  
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